

## **REMARKS**

This amendment is in response to the office action dated and 23, 2004. Claim 1 has been amended, and new claims 2-15 have been added. In the office action, claim 1 was rejected. A detailed discussion of each item in the office action follows.

## **FORMALITIES**

In item 1 of the office action, the Examiner noted typographical errors in paragraphs 38, 41 and 63. The specification has been amended to correct the errors as suggested by the Examiner.

## **THE 102(b) REJECTION**

In items 2-3 of the office action, claim 1 was rejected under 35 U.S.C. 102(b), as being anticipated by Hogan. Hogan does not anticipate Applicant's invention for the following reasons:

1. Hogan is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.
2. Hogan does not disclose the purpose, means or mechanism that this invention discloses.
3. Hogan does not solve the problems that this invention solves.
4. Hogan does not disclose each and every element of this invention.

1. **Hogan is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.**

There is not anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

Hogan is not capable of functioning the same as this invention, as now claimed, because Hogan uses an L-shaped entry which is designed to fit a detacher arm having a particular L-shape. Hogan does not address the problem which occurs when a simple wire is inserted by a thief. As long as the wire is narrow enough in diameter, it will fit through the aperture which is designed for the L-shaped detacher arm. Applicant's invention provides a unique door that hides entry to the inner chamber where the lock resides. Once the pick is inserted, it slides past the door into a dead end chamber. This prevents the lock from being picked. In Applicant's invention, only a rigid detacher arm will be able to overcome the spring tension on the door and allow entry into the detacher chamber. None of the known art teaches or suggests this door mechanism, teaches or suggests the concept of hiding the entrance to the chamber holding the lock, or teaches or suggests rerouting the pick to a dead end cavity that will prevent the lock from being opened.

In response to the office action, Applicant has amended claim 1 and added new claims to include additional elements reciting these features.

2. **Hogan does not disclose the purpose, means or mechanism that this invention discloses.**

There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. v. Aluminum Company of America, 120 U.S.P.Q. 362.

The goals or objects of Applicant's invention, without limitation, are to prevent shoplifters from picking the locks in anti-theft tags. Further, Applicant's invention is directed to providing a unique door mechanism that guides picks away from the chamber where the lock is located.

Hogan cannot meet these objects to the extent that Applicant's invention can, because Hogan has no such door arrangement to conceal the access to the lock from a pick. In addition, the mechanisms by which this invention accomplishes the forenamed objects is substantially different from Hogan. This invention includes a structural means to seal the entrance to the detachment chamber. Hogan it does not seal the chamber. It merely uses an L-shaped portal which will allow entry by a pick. Likewise, Applicant's invention includes a trap: the dead-end cavity, which captures the pick and prevents it from opening the lock.

**3. Hogan does not solve the problems that this invention solves.**

There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

Hogan does not solve the problem of shoplifters who use simple wire picks to penetrate the detacher arm chamber which contains the lock. The unique door provided by Applicant does, by misdirecting it to another location within the anti-theft tag.

**4. Hogan does not disclose each and every element of this invention.**

There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Hogan does not disclose any structural means to redirect a pick away from the locking chamber by concealing the entrance with a door that is configured to route the pick in another direction.

Applicant has amended the claims to include elements which limit the claims to the unique door structure provided by Applicant. For all the reasons set forth above, Applicant's invention, as now claimed, is not anticipated by Hogan.

## **THE 103 REJECTION**

In items 4-5 of the office action, claim 1 was rejected under 35 U.S.C. 103, as being obvious in light of Nguyen/Sayegh/Yamamoto.

The Section 103 objection only applies:

. . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Applicant's invention is not obvious and thereby unpatentable in view of Nguyen/Sayegh/Yamamoto for the following reasons:

**1. The reference cited does not make obvious Applicant's invention as a whole.**

The obviousness inquiry is not whether each element can be found in the prior art, but whether the prior art made obvious the invention as a whole. Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 5 U.S.P.Q.2d 1788 (Fed. Cir. 1988); Hartness Int'l. Inc. v Simplimatic Eng. Co., 819 F.2d 1100, 1108, 2 U.S.P.Q. 1826, 1832 (Fed.Cir. 1987); and ACA Hosp.Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Nguyen/Sayegh/Yamamoto specifically teaches a device with a structure that uses a unique aperture as taught by Hogan. They do not hide the entrance to the detacher arm chamber as does Applicant. They do not teach a method of directing a pick away from the entrance to the lock's chamber, such that the pick will fail by directing the pick toward a dead-end cavity. Applicant's invention is designed to hide the entrance to the detacher arm chamber, to misdirect the pick to a dead-end cavity, and has unique structural features to accomplish those objectives. Nguyen/Sayegh/Yamamoto does not teach or suggest a solution to the problem which

Applicant's invention solves. They do not teach or suggest a method of defeating a pick by misdirecting it away from a lock. Further, they lack the claim elements, as now amended, designed to achieve those goals. They merely attempt to block entrance of the pick.

**2. The invention in Nguyen/Sayegh/Yamamoto is not designed to accomplish the objects and goals of Applicant's invention, as set forth more fully herein.**

A finding of obviousness cannot be made by combining the teachings of the prior art to produce the claimed invention if the prior art does not specifically teach or suggest that the combination be made. Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 U.S.P.Q. 337, (Fed. Cir. 1985), vacated and remanded, 106 S.Ct. 1578, 229 U.S.P.Q. 478 (1986), aff'd in part and rev'd in part, 810 F.2d 1561, 1568, 1 U.S.P.Q. 2d 1593, 1597 (Fed. Cir. 1987), In re Stencil, 828 F.2d 751, 755, 4 U.S.P.Q. 2d 1071, 1073 (Fed. Cir. 1987), citing Interconnect Planning Corp. V. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and In re Corkill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. 1005, 1009-10 (Fed. Cir. 1985).

Nguyen/Sayegh/Yamamoto is clearly designed to block entrance of picks that have particular shapes. They do not block all picks. Applicant's invention is designed to defeat any type of pick because it is not concerned with the shape of the pick. Rather, it relies on its ability to conceal the entrance to the detacher arm chamber and thereby reroute the pick to another location in the tag, namely, the dead-end cavity. Because Nguyen/Sayegh/Yamamoto is not directed to rerouting the pick, it could never be used to solve the problem that Applicant's invention solves.

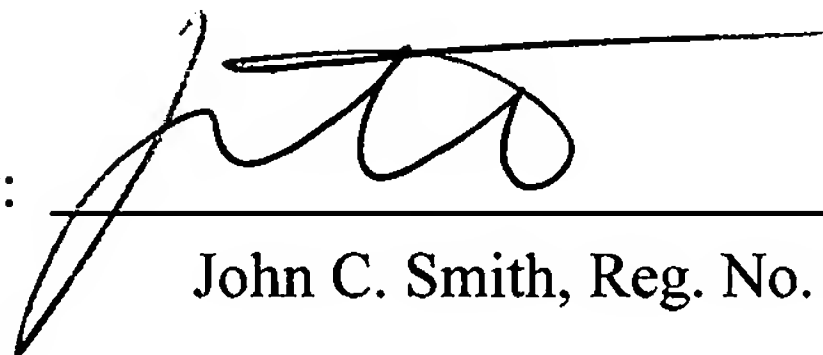
To more particularly define Applicant's invention over the prior art, independent claim 1 has been amended to more clearly describe the use of the door as a method of concealing entrance to the detacher arm chamber. In addition, new claims have been added to further define the features of Applicant's invention. These features include the door, and the dead-end cavity.

## CONCLUSION

Applicant's Attorney thanks the Examiner for the Examiner's help in prosecuting this invention. In response to the office action, Applicant's Attorney has amended the specification and claim 1; and added new claims 2-14. Applicant's Attorney has been careful to avoid the introduction of new matter. In addition, a separate petition and fee for a three month extension of time is attached. Applicant's Attorney believes that all items in the office action dated June 23, 2004 have been addressed, and respectfully requests the Examiner to reconsider the claims, as amended, with a view towards allowance. Applicant's Attorney further invites the Examiner to contact Applicant's Attorney for a telephonic interview at the below listed number if the Examiner believes that prosecution of the application can be furthered by so doing.

Respectfully submitted,

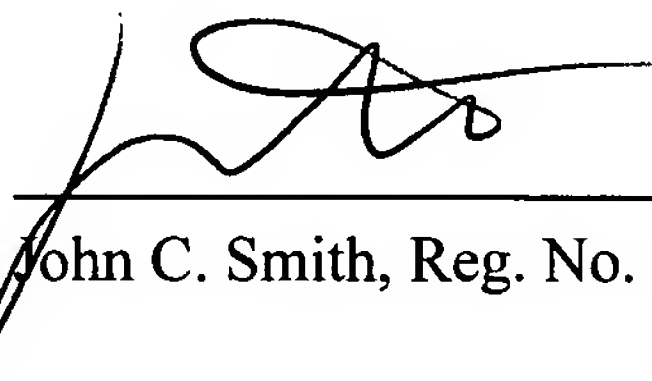
By:



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on: December 23, 2004  
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December 23, 2004  
Signature Date